

### **REMARKS**

Reconsideration and allowance are respectfully requested in view of the foregoing amendments and the following remarks.

Upon entry of this Amendment, claims 1-41 are pending in the application. Claims 14, 24, and 26 have been amended and claims 31-41 have been added.

#### **Rejections of Claims Over Prior Art**

Claims 1-3, 5-6, 9-10, 12, 23-24, and 28 are rejected under 35 U.S.C. §103(a) over West (U.S. Design 244,090) in view of Smyj (U.S. Patent No. 6,360,448). Also, claims 13-15, 17, 19-20, 25, and 29 are rejected under 35 U.S.C. §103(a) over West in view of Smyj. These rejections are respectfully traversed.

Claim 1 is directed to a guiding device that includes an elongated finger resting surface, an elongated upstanding section projecting upwardly from the finger resting surface, an elongated scale supporting section coupled to and extending along the upstanding section, and an elongated first scale made of metal having a lower surface and an upper surface with the lower surface being rigidly and unreleaseably attached to the scale supporting section.

Neither West nor Smyj disclose or suggest a guiding device as recited in claim 1. In the Office Action, the Office Action asserts that West discloses the invention as claimed but lacks an elongated first scale made of metal. The Office Action then relies on Smyj to teach the metal scale. However, the Smyj reference is directed to a layout system in which a length of measuring tape is placed on the base of a building structure, e.g., a foundation, so that dimensions of a structure are permanently placed on the base. As a result, the system remains visible for each tradesman without the need for re-measurement. This eliminates the need for manual measurement in the construction of buildings. Accordingly, Smyj does not provide motivation for providing its scale on a movable ruler as in West. Moreover, Smyj teaches away from placing a scale on a hand-manipulated guiding device as claimed.

That is, Smyj discloses placing a tape 10 on permanent, unmovable members so that the dimensions of a structure “are permanently on the base of the structure so that the system remains visible for each tradesman ... without the need for re-measurement of the structure,” so that dimensions of a building structure “will be available for future reference.” (Col. 6, lines 15-25.) One of ordinary skill in the art would not be motivated in view of Smyj to provide the tape 10 of Smyj onto the ruler of West. The ruler of West is a movable, hand-held device, while Smyj teaches placing tape 10 on, for example, the floors of buildings as seen in Fig. 3 of Smyj. Since there is no proper motivation for providing the tape 10 on the

ruler of West, the rejection is improper. It is respectfully requested, therefore, that the rejection of claim 1 be withdrawn.

Claims 2-3, 5-6, 9-10, 12, 23-24, and 28 are allowable by virtue of their dependence on claim 1 and further for their recitation of additional patentable subject matter. For example, neither West nor Smyj disclose that the finger resting surface is parallel to a first bottom surface positioned beneath the finger resting surface, as recited in claim 24. In contrast, as shown in Figure 3 of West, the finger resting surface thereof is clearly inclined with respect to the bottom surface thereof.

In claim 24 as in claim 14 and 26, the word “substantially” has been removed from the claim. It is Applicants’ position that the word “substantially” is well-understood in the art and that the bottom surface of the West ruler is not “substantially parallel” to what is being construed as a finger-resting surface. However, to expedite prosecution, the word “substantially” has been deleted before the word “parallel” with the understanding that the word “parallel” without the word “substantially” defines two surfaces that are parallel to the extent that it is possible to make surfaces parallel, while allowing for slight variations. Since the bottom surface of the West ruler and the surface of the West ruler being construed as being the finger-resting surface are inclined with respect to each another and are not intended to resemble parallel surfaces as understood in the art, the surfaces are not “parallel” as claimed.

Also, with respect to claim 13, neither West nor Smyj disclose or suggest a guiding device that includes an elongated first portion having a finger resting surface, an elongated second portion extending along the first portion and having an upstanding section and an inclined scale supporting section, and an elongated first scale having a lower surface rigidly and unreleaseably attached to the scale supporting section, as recited in claim 13. As discussed above, Smyj does not provide proper motivation for providing a scale on a movable ruler as in West and, in fact, Smyj teaches away from placing a scale on a hand manipulated guiding device as claimed. It is respectfully requested, therefore, that the rejection of claim 13 be withdrawn.

The Office Action relies upon Ex parte Masham as a teaching that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitation. While this may be true with respect to anticipation and §102 rejections, the teachings of Ex parte Masham do not apply to obviousness rejections under §103, as is the

case here. The rejection analyzed in Ex parte Masham was an anticipation rejection under §102, not an obviousness rejection under §103. Ex parte Masham, 2 USPQ2d 1647 (Pat. Bd. App. 1987).

Claims 14-15, 17, 19-20, 25, and 29 are allowable by virtue of their dependence on claim 13 and further for their recitation of additional patentable subject matter.

Claims 4 and 7-8 are rejected under 35 U.S.C. §103(a) over West and Smyj and further in view of Russo (U.S. Patent No. 1,091,461). Also, claims 16 and 18 are rejected under 35 U.S.C. §103(a) over West and Smyj and further in view of Russo. These rejections are respectfully traversed.

The Office Action relies on Russo to teach that the finger resting surface, the upstanding section, and the scale supporting section are formed of plastic. Also, the Office Action relies on Russo to teach that the contact surface includes second indicia indicating predetermined lengths along the contact surface, and that the second indicia is printed on the contact surface. This does not make up for the deficiencies noted above with respect to West and Smyj. Accordingly, claims 4 and 7-8 are allowable by virtue of their dependence on claim 1 and further for their recitation of additional patentable subject matter. Claims 16 and 18 are allowable by virtue of their dependence on claim 13 and further for their recitation of additional patentable subject matter.

Claim 11 is rejected under 35 U.S.C. §103(a) over West and Smyj and further in view of Okamoto (JP-05139089). This rejection is respectfully traversed.

The Office Action relies on Okamoto to teach that the second side of the upstanding section includes a plurality of ribs. This does not make up for the deficiencies noted above with respect to West and Smyj. Moreover, the plurality of ribs 33 of Okamoto are provided on a flat surface thereof and not on an upstanding section as claimed. Okamoto does not disclose or suggest that the second side of the upstanding section includes a plurality of ribs, as recited in claim 11. Accordingly, withdrawal of the rejection of claim 11 is respectfully requested.

Claims 21-22, 26-27, and 30 are rejected under 35 U.S.C. §103(a) over West in view of Troyer et al. (U.S. Patent No. 4,149,320). This rejection is respectfully traversed.

Claim 21 is directed to a guiding device that includes an elongated finger resting surface, an elongated upstanding section projecting upwardly from the finger resting surface, an elongated scale supporting section coupled to and extending along the upstanding section,

and an elongated first scale having a lower surface and an upper surface with the lower surface being rigidly and unreleaseably attached to the scale supporting section.

Neither West nor Troyer disclose or suggest the guiding device as recited in claim 21. Similar to the West and Smyj combination described above, the Examiner relies on the Troyer reference to teach an elongated first scale. However, the Troyer reference is directed to a measuring tape that is permanently secured to a structural base, e.g., a building foundation, to facilitate the placing of structural members without manual measurement. Thus, the Troyer reference fails to provide motivation for attaching its measuring tape to a ruler as in West and teaches away from the claimed guiding device.

That is, Troyer discloses placing a tape 1 on “buildings and other static structures” (Col. 5, lines 5-9) to “eliminate the necessity for manual measurement” (Col. 1, lines 7-8). See also, col. 7, lines 7-11; col. 8, lines 6-8; and col. 9, lines 17-20. One of ordinary skill in the art would not be motivated in view of Troyer to provide the tape 1 of Troyer onto the ruler of West. The ruler of West is a movable, hand-held device, while Troyer teaches placing tape 1 on, for example, the walls of buildings as seen in Fig. 4 of Troyer. Since there is no proper motivation for providing the tape 1 on the ruler of West, the rejection is improper. It is respectfully requested, therefore, that the rejection of claim 21 be withdrawn.

Claims 22, 26-27, and 30 are allowable by virtue of their dependence on claim 21 and for their recitation of additional patentable subject matter. For example, the Office Action contends that the finger resting surface is parallel to a first bottom surface positioned beneath the finger resting surface, as recited in claim 26. In contrast, as shown in Figure 3 of West, the finger resting surface thereof is clearly inclined with respect to the bottom surface thereof.

#### New Claims

New claims 31-41 have been added. Entry and allowance of these new claims is respectfully requested.

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All rejections have been addressed. It is respectfully submitted that the present application is in condition for allowance, and a notice to that effect is earnestly solicited.

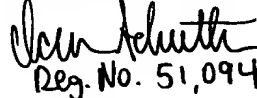
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JIMENEZ ET AL. -- 09/852,051  
Client/Matter: 081427-0278455

Should there be any questions or concerns regarding this application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,

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